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SF

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/589,476 06/07/00 CARSON

D 103.021US1

021186 HM12/0503  
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EXAMINER

GOLDBERG, J

ART UNIT

PAPER NUMBER

1614  
DATE MAILED:

5  
05/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/589,476

Applicant(s)

Carson

Examiner

Jerome D. Goldberg

Group Art Unit

1614

☒ Responsive to communication(s) filed on Feb 20, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-33 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-33 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1614

Restriction to one of the following inventions is required under 35 U.S.C. 121.

Group I: Claims 1,3,4,11,13,14 and 26-29 drawn to treating cancer with etodolac or analog thereof alone.

Group II: Claims 2-10, 12, 15-18 and 31-33 drawn to treating cancer with an enhanced combination of the Group I compound and a chemotherapeutic agent.

Group III: Claims 19-25 drawn to a <sup>method</sup> for evaluating the ability of etodolac to sensitize cancer cells to a chemotherapeutic agent.

If applicants elect Group II, they are further required to elect a single enhanced combination of are compound of Group I with one chemotherapeutic agent for examination on the merits.

The several inventions above are independent and distinct, each from the other, as they have acquired a separate status in the art of treating cancer as a separate subject matter for inventive effect and require independent searches. It is noted that a reference to one enhanced <sup>would not be a reference to another enhanced combination of drug</sup> combination of drugs under 35 U.S.C. 103. Further, the claims read on a multitude of enhanced combinations of drugs which would require many field of searches that would be an undue burden on the Examiner. Therefore, restriction for examination purpose is proper.

Applicant are required to make a provisional election even though this requirement is traversed.

Art Unit: 1614

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner J. D. Goldberg whose telephone number is (703) -308-4606. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Cintins, can be reached on (703) -308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) -308-4556 or 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) -308-1235.

Goldberg/LR

April 27, 2001



JEROME D. GOLDBERG  
PRINCIPAL EXAMINER  
GROUP 1200